



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,741	06/13/2000	Theresa M. Gosko	M-9083-US	7322

24251 7590 03/12/2002

SKJERVEN MORRILL MACPHERSON LLP
25 METRO DRIVE
SUITE 700
SAN JOSE, CA 95110

[REDACTED] EXAMINER

FISCHER, ANDREW J

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

2167

DATE MAILED: 03/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/592,741	Applicant(s) Theresa M. Gosko	
	Examiner Andrew J. Fischer	Art Unit 2167	
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --			
<p>Period for Reply</p> <p>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</p> <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 			
<p>Status</p> <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>May 2, 2001</u>.</p> <p>2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>			
<p>Disposition of Claims</p> <p>4) <input checked="" type="checkbox"/> Claim(s) <u>1-20</u> is/are pending in the application.</p> <p>4a) Of the above, claim(s) <u>10-20</u> is/are withdrawn from consideration.</p> <p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6) <input checked="" type="checkbox"/> Claim(s) <u>1-9</u> is/are rejected.</p> <p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.</p>			
<p>Application Papers</p> <p>9) <input checked="" type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input checked="" type="checkbox"/> The drawing(s) filed on <u>Jun 13, 2000</u> is/are objected to by the Examiner.</p> <p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a)<input type="checkbox"/> approved b)<input type="checkbox"/> disapproved.</p> <p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>			
<p>Priority under 35 U.S.C. § 119</p> <p>13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).</p> <p>a)<input type="checkbox"/> All b)<input type="checkbox"/> Some* c)<input type="checkbox"/> None of:</p> <ol style="list-style-type: none"> 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). 			
<p>*See the attached detailed Office action for a list of the certified copies not received.</p>			
<p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p>			
<p>Attachment(s)</p> <p>15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p> <p>16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). <u>2</u> 20) <input type="checkbox"/> Other: _____</p>			

Art Unit: 2167

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, drawn to a data structure for providing a catalog from a manufacture.
 - II. Claims 10-13, drawn to a data structure for acknowledging receipt of a catalog.
 - III. Claims 14-19, drawn to a data structure for providing an order from a customer.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II with III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as allowing a user to browse through an online catalog. See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above, because the search required for Group I is not required for Groups II or III, and because the inventions have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation to Stephen A. Terrile on or about February 21, 2002 a provisional election was made with traverse to prosecute the invention of group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Art Unit: 2167

Information Disclosure Statement

5. The information disclosure statement ("IDS") filed February 22, 2001 (Paper No. 2) fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because a date and place of publication has been omitted. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

6. The Examiner notes that an IDS may be considered without a date and place of publication if an Applicant expressly omits that the listed documents are prior art. In this case, Applicant has declined to do so.

Specification

7. The specification is objected to because of the missing serial numbers found on page 1. Appropriate correction is required.

Art Unit: 2167

Drawings

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claim(s):

- a. The “type indicator” as recited in claim 1.
- b. The “system identification portion” as recited in claim 1.

9. A proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not produce a useful, concrete, tangible result. A data structure alone is non-statutory. See *In re Warmerdam*, 33 F3d 1354, 31 USPQ2d 1754 (Fed Cir 1994). Additionally, a data structure is not one of the statutory classes of patentable subject matter.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow:

- a. In claim 1, the phrase “a system option portion” is indefinite.
- b. Regarding claim 1, the phrase “system type” renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by “system type”), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(b) E.
- c. In claim 3, “a plurality of business rule elements” is indefinite since the ordinary and accustomed meaning of “a plurality of business rule elements” can mean virtually any business rule. Business rules—like most standards—change over time. Additionally, the metes and bounds of what is encompassed by “a plurality of business rule elements” is also indefinite.

Art Unit: 2167

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

15. Claims 1-9, as understood by the Examiner, are rejected under 35 U.S.C. 102(b) as being anticipated by Spallone et. al. (U.S. 4,959,686). Spallone et. al. discloses a method and an electronic catalog.

16. For prior art purposes only, the Examiner interprets the claims to be a method or process claims.

17. Functional recitation(s) using the word "for" (e.g. "for providing a catalog from a manufacturer to a customer" as recited in claim 1) have been given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Art Unit: 2167

18. After careful review of the specification, the Examiner is unaware of any desire—either expressly or implicitly—by Applicant(s) to be their own lexicographer and define a claim term to have a meaning other than its ordinary and accustom meaning. Therefore, the Examiner starts with the presumption that all claim limitations are given their ordinary and accustom meaning.

See *Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1268, 59 USPQ2d 1865, 1870 (Fed. Cir. 2001)(“[T]here is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art.”). See also MPEP §2111.01.

However, if Applicant(s) do desire any claim limitation to have a meaning other than its ordinary and accustom meaning, the Examiner respectfully requests Applicant(s) to expressly indicate the claim limitation at issue and to show where in the specification or prosecution history the limitation is defined. Such definitions must be clearly stated in the specification or file history. *Bell Atlantic*, 262 F.3d at 1268, 59 USPQ2d at 1870, (“[I]n redefining the meaning of particular claim terms away from the ordinary meaning, the intrinsic evidence must ‘clearly set forth’ or ‘clearly redefine’ a claim term so as to put one reasonably skilled in the art on notice

Art Unit: 2167

that the patentee intended to so redefine the claim term").¹ The Examiner cautions that no new matter is allowed.

Failure by Applicant(s) to address this issue in the manner set forth above or to be non-response to this issue entirely will be considered a desire by Applicant(s) to, at least initially, give all claim limitations their ordinary and accustom meaning. Applicant(s) are reminded that even though we start with this presumption, any interpretation disclaimed during prosecution may further limit that claim element. See *Pall Corp. v. PTI Technologies Inc.*, 259 F.3d 1383, 59 USPQ2d 1763, 1769 (Fed. Cir. 2001).

¹ See also *Vitronics*, 90 F.3d at 1582, 39 USPQ2d at 1576, (“[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is *clearly stated* in the patent specification or file history. [Emphasis added.]”); *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (“Such special meaning, however, must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.”). See also MPEP §2111.02, subsection titled “Applicant May Be Own Lexicographer” and MPEP §2173.05(a) titled “New Terminology.”

Art Unit: 2167

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Witek et. al. (U.S. 6,253,188); Johnson (U.S. 6,052,670); and Siefet (U.S. 5,699,526).

20. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

AJ Fischer
ANDREW J. FISCHER
PATENT EXAMINER
2/28/02

AJF

February 28, 2002

Robert P. Olszewski 3/4/02
ROBERT P. OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600 2100